

R E M A R K S

Claims 1 - 62 and 64 - 85 are pending.

Claims 1, 38, 40, 84 and 85 are independent.

Specification Objections

The abstract of the disclosure has been amended so that it does not exceed 150 words.

Claim Objections

Both claim objections are considered moot in light of the discussion below.

Claim 16:

Claim 16 is reproduced below:

16. The method of claim 1, implemented by a **software program**, wherein the preference is defined by a publisher of the **software program**.

The two occurrences of the term "software program" in claim 16 are in bold. The first occurrence provides the antecedent basis for the second occurrence. Since there is no lack of antecedent basis, the objection is assumed to be moot. If there is a different basis for objection of claim 16 other than a lack of antecedent basis, please clarify that basis.

Claim 39:

Claim 39 is reproduced below:

39. The method of claim 38, wherein **presenting the modified markup language file to the user** includes presenting an indication of the hyperlink.

Claim 38 recites the step of "presenting the modified markup language file to the user". Claim 39 depends on claim 38 and similarly refers back to this step. This step is accurate as written - the word "to" was not intended to be "for".

In claim 39, the modified markup language file is presented **to the user**. For example, please see page 12, lines 7 - 8 and Figure 1, step 24 of the present application, which both describe that the modified markup language file is presented to the user.

Section 102 and 103 Rejections

We are extremely grateful for the thorough search of the prior art as well as the detailed analysis of the applicability of the references to each and every pending claim.

Claims **40 - 49, 51, 52, 54 - 83 and 85** (including independent claims **40, 84 and 84**) were rejected as anticipated by Merriman (U.S. Patent No. 5,948,061).

Claims **1 - 12, 15 - 39, 50 and 53** (including independent claims **1 and 38**) were rejected as being unpatentable over a combination of Merriman and Rodkin (U.S. Patent No. 6,092,074).

Claims **13 and 14** were rejected as being unpatentable over a combination of Merriman, Rodkin and Hoyle (U.S. Patent No. 6,628,314).

Claim Amendments

To expedite prosecution and to obtain an issuance as quickly as possible, we have amended all independent claims to focus on specific embodiments of the invention.

However, we do not agree that a *prima facie* case of unpatentability of the claims has been presented. Accordingly, we will present the original claims for prosecution in a continuing application.

As amended, all independent claims include the following limitations

the data pattern defines an arrangement of user-viewable text

the hyperlink is associated with a URL of the computer network resource

the hyperlink is included / inserted at a location that is based on a location of the located data pattern / the matched portion of the electronic file

Therefore, all dependent claims include these limitations as well.

Independent claims **1, 38, 40, 84 and 85** are amended to include the above limitations.

Dependent claims **50 and 61** are amended to remain consistent with the limitation of independent claim **40** that recites that the *data pattern defines an arrangement of user-viewable text*.

Dependent claim **63** is canceled since the limitation of that claim is incorporated in independent claim **40**. Claims **64 - 67, 69 and 70** were dependent on canceled claim **63**, so they are amended to depend on independent claim **40**.

The References Do Not Suggest These Limitations

There are several manners in which the claims distinguish over the references. However, for expediency only one significant distinction is discussed below.

As noted by the Examiner in the rejection of independent claim **40**, in Merriman the web pages of affiliates all include a "code that indicates the banner advertising will be inserted into the affiliate web page". Office Action, page 2, last paragraph.

By contrast, all pending claims require that the *data pattern defines an arrangement of user-viewable text*. To the extent that Merriman's code indicating the banner could be considered a pattern, that pattern certainly is the opposite of *user-viewable text* - it is invisible tags.

Thus, when, for example, the electronic file is evaluated to recognize a match between a portion of the electronic file and the data pattern, the electronic file is evaluated for *an arrangement of user-viewable text*.

This stark contrast with Merriman exists because in Merriman the web page is authored specifically and simplistically to include a banner advertisement - a tag is inserted to indicate where the advertising is placed. By contrast, the present application discloses that even pages which are not specifically authored to include, e.g., certain links can be modified to include various links, depending on various patterns of user-viewable text in the page. In fact, the present application discloses that any web page could potentially be modified to include a hyperlink.

Rodkin similarly is concerned with searching for anchor codes (tags), not *user-viewable text*. Further, nothing in Rodkin allows for any sort of *customized viewpoint*.

No Motivation to Combine

The motivation to combine references must be demonstrated by some reference in the record. The motivation must be a specific teaching or suggestion in the prior art to combine or modify the references of record in the manner proposed.

The motivation provided to combine Merriman and Rodkin is

"for the purposes of automatically providing hypertext anchor codes and destination addresses for a user-readable text file at a content server and allowing the updating of links without requiring further processing of the computer file".

Office Action, rejection of claim 1.

As best of we understand this motivation, it as a statement of what Rodkin purports to do. In fact, the stated motivation is taken verbatim from Rodkin. See, Rodkin, Background, Col. 3, lines 40 - 42 and Rodkin, Summary of the Invention, Col. 3, lines 61 - 63.

However, this is not a motivation to seek out the system disclosed by Merriman and combine that system with Rodkin. In fact, it is not clear why anyone of ordinary skill in the art would seek out Merriman in an attempt to:

"automatically [provide] hypertext anchor codes and destination addresses for a user-readable text file at a content server"

or to:

"[allow] the updating of links without requiring further processing of the computer file"

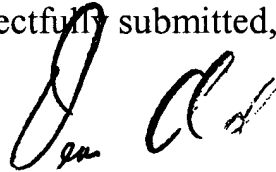
Merriman has nothing to do with either of these two objectives. Even if it did, since these objectives are purportedly met by the disclosure of Rodkin, there would be no need for one seeking these goals to look to any other reference at all, much less Merriman in particular.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Respectfully submitted,



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